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7590 07/29/2008  
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EXAMINER

LUONG, VINH

ART UNIT

PAPER NUMBER

3682

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07/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,584	<b>Applicant(s)</b> DUPONT ET AL.	
	<b>Examiner</b> Vinh T. Luong	<b>Art Unit</b> 3682	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachment</u>                         |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 6, 2008 has been entered.
2. The drawings were received on May 6, 2008. These drawings are accepted by the Examiner.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-8, 11, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear:

(a) whether the term "the *weld* fusion" (emphasis added)" in Claim 3/1 refers to "a fusion interface" or "a welding process" in Claim 1; and

(b) whether a confusing variety of terms, such as, "the proximal retaining element" and "a corresponding first retaining element" in Claim 1 refer to the same or different things. See MPEP 608.01(o) and double inclusion in MPEP 2173.05(o).

Claim 3 recites the limitation "the *weld* fusion" (emphasis added) in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the shell" in line 3. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 1, 2, and 14, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Michel (FR 2 730 772 cited as category X reference in Applicant's PCT Application).

Regarding Claim 1, Michel teaches a control device for a module (unnumbered, shown by dashed lines in FIG. 2 as seen in Attachment hereinafter "Att.") forming a lock mechanism, the control device comprising:

a cable 6 having a proximal end 7 (FIG. 1 in Att.) and a distal end (Att.) respectively,

a jacket 8 housing the cable 6; the jacket 8 having a proximal end (FIG. 1 in Att.) and a distal end (FIG. 1 in Att.) respectively, the proximal and distal ends of the jacket 8 are immobilized by proximal and distal retaining elements (FIGS. 1 and 2 in Att.),

wherein at least the proximal end of the jacket 8 is connected to a corresponding first retaining element 2 by means of a connecting element 1 attached to the proximal end of the jacket 8, and

wherein a fusion interface 22 is provided between the connecting element 1 and the proximal retaining element 2 at a location offset laterally from an axis III-III (FIG. 2) of the jacket 8. The fusion interface 22 is capable of avoiding deformation of the jacket 8 during a welding process.

Claim 1 and other claims below are anticipated by Michel since Michel teaches each and every positively claimed element in the claim. As noted, the recitation "to avoid deformation of the jacket (18) during a welding process" denotes an intended use. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). On the other hand, the “wherein” or “whereby” clause that merely states the inherent results of limitations in the claim adds nothing to the claim’s patentability or substance. *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); and *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Regarding Claim 2, the connecting element 1 is overmolded or capable of being overmolded on the proximal end of the jacket 8 as seen in Figs. 1 and 8. Referring the control device to the process of overmolding is not accorded patentable weight. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006) and MPEP 2113.

Regarding Claim 14, said fusion interface 22 is disposed within an enclosed space defined between the connecting element 1 and the first retaining element 2 as seen in FIGS. 4, 10, and 9.

6. Claims 1-8, 11, and 14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel in view of Chiang (US Patent No. 6,179,669).

Regarding Claim 1, Michel teaches the invention substantially as claimed. See the rejection under 35 USC 102(b) above. However, Michel does not teach the welding process.

Chiang teaches the welding process in order to connect the connecting element 32 and the retaining element 52. Chiang, col. 5, lines 24-37.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use welding process in order to connect Michel's connecting element to Michel's first retaining element as taught or suggested by Chiang. The use of welding process in Michel's control device would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). See also *In re Thorpe*, *SmithKline Beecham Corp. v. Apotex Corp.*, and MPEP 2113 *supra*.

Regarding Claim 2, Michel teaches the process of over-molding of the connecting element 1 on the first end of the jacket 8. See pages 6-8 of the translation. Similarly, Chiang teaches the well known over-molding in col. 5, lines 24-37.

Regarding Claim 3, Michel's connecting element 1 is capable of being ultrasonically welded to the proximate retaining element 2 as taught or suggested by Chiang. *In re Thorpe*, *SmithKline Beecham Corp. v. Apotex Corp.*, and MPEP 2113 *supra*.

Regarding Claim 4, Michel's connecting element 1 and the proximate retaining element 2 comprise complementary welding faces 24 and 22 (FIGS. 5 and 8), each provided with fusible ribs 25 and 22, the ribs 25 borne by the welding face 24 of the connecting element 1 being substantially perpendicular to the ribs 22 borne by the welding face 22 of the proximate retaining element 2, and wherein the fusion interface 22 is formed between the ribs 25 and 22 of the complementary welding faces 24 and 22.

Regarding Claim 5, the complementary welding faces 24 and 22 are provided on complementary interlocking parts 24 and 22 of the connecting element 1 and the proximal retaining element 2.

Regarding Claim 6, the interlocking part 24 of the first retaining element 2 forms a longitudinal channel 18 (Fig. 5) for the interlocking of the connecting element 1, the welding face 22 of the first retaining element 2 forming a base of the channel 18, the ribs 22 of the first retaining element 2 extending longitudinally.

Regarding Claim 7, the complementary interlocking parts 24 and 22 of the connecting element 1 and of the proximal retaining element 2 comprise complementary welding shoulders 28 and 20 (Fig. 9) and wherein the fusion interface 22 is formed between the complementary welding shoulders 28 and 30.

Regarding Claim 8, the proximate retaining element 2 contains two ribs 22 extending longitudinally on either side of the jacket 8 and two welding shoulders 20 extending longitudinally on either side of the jacket 8 so that the ribs 22 and the welding shoulders 20 of the first retaining element 2 are offset laterally with respect to the axis III-III (FIG. 2) of the jacket 8 as seen in FIGS. 4, 6, and 10.

Regarding Claim 11, the proximal end 7 (FIG. 1 in Att.) of the cable 6 is provided with a block 7 (Fig. 8) for securing this cable 6, the shell 12 (FIG. 6) forming a housing for the securing block 7.

Regarding Claim 14, the fusion interface 22 is disposed within an enclosed space defined between the connecting element 1 and the first retaining element 2 as seen in FIGS. 4, 10, and 9.

7. Applicant's arguments filed May 6, 2008 have been fully considered but they are not persuasive.

### **DRAWINGS**

The replacement drawings filed on May 6, 2008 have been accepted.

### **SPECIFICATION OBJECTION**

The objection is withdrawn in view of Applicant's amendments.

### **35 USC 112, SECOND PARAGRAPH**

The current claims do not conform to the requirement of 35 USC 112 as seen above.

### **35 USC 102**

Applicant contended:

Michel fails to disclose a fusion interface provided between the connecting element (22) and the proximal retaining element (20P) at locations offset laterally from an axis of the jacket (18). Contrary to the present invention as recited in claim 1, the mutual fixing of the first and second elements of Michel is in the form of serrations (24) in the first element engaging with internal serrations (22) on the second element, while the locking of the two elements is achieved by a projection (25) on the first element engaging with a slot (26) in the second element.

The Examiner respectfully submits that Applicant apparently uses an "*ipsissimis verbis*" test that requires the same terminology in the prior art reference in order to find anticipation. See footnote 11 of *AKZO N.V. v. International Trade Commission*, 1 USPQ2d 1241, 1245 (CAFC 1986). It is well settled that an inventor can be his/her own lexicographer. Thus, Michel does not need to use the same terminology as Applicant uses. More importantly, it is well settled that an anticipatory reference needs not duplicate word for word what is in the claims. Anticipation can occur when a claimed limitation is "inherent" or otherwise implicit in the relevant reference.



*Standard Haven Products Inc. v. Gencor Industries, Inc.*, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991).

As noted in MPEP 2111, during patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); and *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). In addition, it is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference “teach” what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, “read on” something disclosed in the reference, i.e., all limitations of the claim are found in reference, or are “fully met” by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983).

In the instant case, the *Webster's II New Riverside University Dictionary*, 1994, defines “fusion” as “the act or procedure of liquefying or melting together by heat.” Here, Michel's connecting element 1 and proximate retaining element 2 are made of molded plastic material as described, e.g., on page 6 of the translation. Therefore, if one applies sufficient heat to Michel's elements 1 and 2, these elements are inherently melted in the same manner as Applicant's molded material. On the other hand, as illustrated in Michel's drawings, especially, FIGS. 4, 9, and 10, an interface 22 is provided between the connecting element 1 and the proximal retaining

element 2 at locations offset laterally from an axis III-III of the jacket 8. Therefore, the interface 22 “reads on” Applicant’s claimed “fusion interface.”

On the other hand, Applicant’s arguments are not based on the limitations appearing in independent Claim 1. In fact, the recitation “to avoid deformation of the jacket (18) during a welding process” merely denotes an intended use or an inherent result of the structures recited in the body of the claim. Therefore, such recitation does not import patentable weight to the claim. *In re Casey*; *In re Otto*; and *Texas Instruments Inc. v. International Trade Commission, supra*.

For the foregoing, the rejection of Claim 1 under 35 USC 102 is respectfully maintained.

### **35 USC 103**

Applicant asserted, *inter alia*, that: (a) the locking of Michel’s two elements 1 and 2 is achieved by the projections 25 engaging with the slot 26; and (b) if the first element 1 is welded to the second element 2, the device of Michel would no longer be adjustable, therefore, the welding teaches away from the present invention.

First, the welding process is not positively claimed as noted from Applicant’s independent Claim 1. Therefore, Applicant’s arguments regarding welding process are immaterial with respect to Claim 1.

Second, the Court in *In re ICON Health and Fitness Inc.*, 83 USPQ2d 1746 (Fed. Cir. 2007) stated:

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 [31 USPQ2d 1130] (Fed. Cir. 1994); see *KSR*, 127 S. Ct. at 1739–40 (explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious). Additionally, a

reference may teach away from a use when that use would render the result inoperable. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 [60 USPQ2d 1001] (Fed. Cir. 2001).

MPEP 2145 further states:

A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness; however, “*the nature of the teaching is highly relevant and must be weighed in substance*. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials.

The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant’s purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

Furthermore, “*the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...*” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). (Emphasis added).

In the case at hand, Michel teaches to form the elements 1 and 2 of molded plastic material. It is notoriously well known to use ultrasonic welding to connect two molded elements together as evidenced by, e.g., Chiang reference. Thus, the combination of Michel and Chiang is more likely to be obvious modification since it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *KSR, supra*.

More importantly, if one having ordinary skill in the art uses the welding to connect Michel's elements 1 and 2 together, one does not render Michel's device to be inoperative since Michel's cable 6 is still slid within the jacket 8 to transmit the motion from the module element (FIG. 2 of Att.) to another element, such as, a wall of a heating/ventilation or air conditioning apparatus of an automobile. See last paragraph on page 6 and first paragraph on page 7 of the translation. Since the nature of Michel's teaching of motion transmitting cable 6 is highly relevant and must be weighed in substance, thus, the known or obvious welding connection does not become patentable simply because Michel has been described as somewhat inferior to Applicant's motion transmitting device for the same use. *In re Gurley, supra*.

On the other hand, Michel's projections 25 and slot 26 are used to adjust the positions of the elements 1 and 2. However, when the elements 1 and 2 are in a fixed position as shown in FIGS. 4, 9, and 10, one can choose not to adjust the elements 1 and 2. Simply put, the elements 1 and 2 can be fixed together at a fixed position if one so desires. Put in another fashion, the connection of the elements 1 and 2 by welding is equivalent to the connection of the elements 1 and 2 by the projections 25 and slot 26 at their fixed position shown in FIGS. 4, 9, and 10.

In summary, Michel's disclosure of more than one alternative (adjustability positions of the elements 1 and 2) does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution of a fixed position claimed. Consequently, Michel does not teach away from Applicant's alternative of welding connection. *In re Fulton, supra*.

## CONCLUSION

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For the foregoing, Applicant's solicitation to allow the instant case is respectfully declined.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/

Primary Examiner, Art Unit 3682